

REMARKS

In response to the Office Action dated March 14, 2008, new claims 49 and 50 have been added and claims 41-46 have been withdrawn. No new matter has been added. Reexamination and reconsideration of the claims as requested is respectfully requested.

Restriction Requirement (related Products or related Processes)

In paragraph 1 on page 2 of the final Office action dated March 14, 2008, a restriction requirement in regard to claims 41-46 has been made final.

Applicant continues to disagree with the restriction requirement with respect to claims 47 and 48 for reasons provided in the previous response. A "control measure" is not a new feature, since it is a generic term that encompasses devices such as, e.g., a pump controller, which was previously in the claims (see, e.g., claim 6 of the preliminary amendment submitted on April 15, 2002 – reference to claim 7 in the previous reply was due to a typographical error).

With respect to the new (and apparently final) restriction requirement withdrawing claims 41-46 from consideration, Applicant disagrees with this restriction requirement. The Examiner states that the amended claims are directed to a different invention than the previous claims because "[t]he previously examined method of taking up did not require a liquid to be present/provided or any determining step as claimed". Applicant notes that the step of "providing the medium ..." was added in response to a previous rejection under 35 U.S.C. § 112, in which the Examiner objected that steps – such as providing the medium – seemed to be missing. In any event, this step does not change the invention, since it was clear from previous versions of the claim that there was a

medium that was being taken up. The "determining" step also does not change the invention, since it merely restates, in a more direct form, the determination of the critical pressure, which was present in earlier versions of the claim. The Examiner further states that "it is unclear how the method can be referred to as a method for analyzing when there is no analysis step provided in the claim". This also does not change the invention from what was previously claimed. It has always been clear from the claims that the purpose of taking up the liquid is to analyze it. Further, the language to which the Examiner refers is no more than a statement of intended use occurring in the preamble of the claim, which is not limiting (see, e.g., MPEP 2111.02), and does not change the invention. For at least these reasons, Applicant disagrees with the restriction requirement with respect to claims 41-46.

Applicant has added new claims 49 and 50, which are similar to the withdrawn claims 41 and 43, but which recite a "method for taking up a medium to be analysed" instead of an analysis method, as was objected to by Examiner when withdrawing claims 41-46 from consideration. Additionally, claim 49 removes "providing the medium to be analysed", since the Examiner seems to object to this step being present. New claim 49 retains the step of determining the critical pressure, since this is (and always has been) an important feature of the invention. This is not new, and does not change the invention from what was previously presented and examined. The critical pressure has always been present in the claims (despite Examiner's apparent determination to ignore it), and ensuring that the negative pressure does not go below this critical pressure implicitly indicates a determination of the critical pressure. Therefore, this step

only makes explicit what was already implicit in the claims, and does not constitute a "different invention" from what has been previously presented and examined.

In paragraph 4 on page 6 of the Office Action, claim 37 is rejected under 35 U.S.C. § 112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which is regarded as the invention. Applicant respectfully traverses this rejection, but has amended the application to overcome the objections. It is believed that all claims comply with 35 U.S.C. § 112. More specifically, the Office action states:

The equation of claim 37 is not further limiting of the structure, but state how one intends to calculate the critical pressure (see above explanation in Response to Arguments).

Claim 37 states a relationship between various claim features, and specifies a particular configuration of the apparatus. Combinations of features not satisfying the relationship and configuration stated in the recited equation are outside of the scope of protection of this claim, while combinations of features satisfying the relationship and configuration stated in the recited equation are within the scope of protection. The subject-matter of claim 37 is therefore limiting and also definite since it particularly points out and distinctly claims the subject matter which Applicant regards as the invention.

It is accordingly believed that the claim 37 meets the requirements of 35 U.S.C. § 112.

In paragraph 7 on page 6 of the Office Action, claims 35-40 are rejected under 35 U.S.C. §102 (b) as being anticipated by Bjorkman (US 4,642,220). Applicant respectfully traverses this rejection.

In paragraph 8 on page 7, claims 35-46 are rejected as being anticipated by Moulton (US 5,851,491), Applicant respectfully traverses this rejection.

In paragraph 9 on page 8 of the Office Action, claims 35-40 are rejected under 35 U.S.C. §102 (e) as being anticipated by Kitajima, et al. (US 6,226,130). Applicant respectfully traverses this rejection.

Claim 35 (similarly claims 41, 47, and 48) recite, *inter alia*:

a pipette for taking up a medium to be analysed, said pipette having a diaphragm containing at least one pore of a given radius;

a pump, said pump producing a negative pressure in said pipette and ***said pump being configured such that said negative pressure does not go below a critical pressure*** at which the surface tension of a liquid present at said at least one pore of said diaphragm would be overcome.

(Emphasis added.)

In item 2 in the *Response to Arguments* on page 4 of the Office action, it has been argued that:

As to applicant's remarks directed to the critical pressure, the examiner maintains his previous interpretation of the claim. Since ***no specified values*** are given, the ***structural requirement of the pump is that it be capable of producing a negative pressure***. Adequate factors (those previously given by the examiner) can be freely chosen by an operator such that the negative pressure produced by the pump overcomes a critical pressure (as broadly defined by applicant).

...

... applicant admits the examiner's about the dependency of the broadly recited "critical pressure" is dependent upon a number of factors. However applicant still attempts to argue the broadly defined negative pressure as recited in the configured such phrase in combination with the specification paragraphs [0099] and paragraphs [100] is sufficient to overcome the rejections.

(Emphasis added.)

As stated in the previous response, the critical pressure is dependent upon a number of factors. However, the claim feature "critical pressure" is clearly and unambiguously defined *in* the claims; namely, the negative pressure ***at which the surface tension of a liquid*** present at the at least one pore of said diaphragm ***would be overcome***. Merely providing a pump that is capable of producing a negative pressure is not sufficient to meet this limitation, since such a pump would not be "configured such that said negative pressure does not go below a critical pressure at which the surface tension of a liquid present at said at least one pore of said diaphragm would be overcome", as claimed.

This is an important feature of the present invention since it makes "it possible to ascertain automatically [sic] whether all of the analyte ... has been taken up" (Paragraph 099) and "automatedly [sic] ensured that no medium other than the material to be analysed is taken up" (Paragraph 100). (Note – since there appears to have been some confusion on this point, paragraph numbers refer to the paragraph numbers in the published version of the application, US Published Patent Application No. 2002-0127705. This is done for convenience. Paragraphs 99 and 100 correspond to p. 7, line 33 – p. 8, line 2 of the specification submitted on 01/18/02)

In paragraph 5 on page 6 of the Office action, titled "Claim Interpretations" states:

For the purpose of examination, a system comprising an aspirating or vacuum device capable of aspirating a liquid or gas and including a porous structure (filter, frit, membrane, disc with a hole/aperture, etc.) with a pore having a radius and pump capable of producing a negative pressure is considered equivalent to the device as claimed by applicant.

It is clear that the Examiner persists in giving no weight to the claim limitation that the pump is configured such that the pressure does not go below a "critical pressure",

which is recited and defined in the claims as the negative pressure at which the surface tension of a liquid present at said at least one pore of said diaphragm would be overcome. This is an important claimed limitation of the present invention, and cannot simply be ignored. This is particularly important, since this claimed feature is not found in any of the cited art.

Furthermore, it has been argued:

As to the examples in the specification referenced by applicant, it should be noted that the claims are read in light of the specification. However, limitations disclosed in the specification, but not positively claimed in the claims are not read into the claims.

The Examiner is correct. Limitations disclosed in the specification are normally not read into the claims. The embodiments disclosed in the specification were mentioned in the previous response only to show that there is **sufficient disclosure**, not for arguing patentability of the claims in view of the applied prior art.

None of *Bjorkman*, *Moulton*, or *Kitajima et al.* disclose or suggest a pipette for taking up a medium, the pipette having a diaphragm with a pore, and a pump producing a negative pressure, the pump configured such that the negative pressure does not go below a critical pressure at which the surface tension of the liquid present at the pore would be overcome. As argued above, art that shows a pump that produces a negative pressure is insufficient to show the "critical pressure" limitation of the claims, since the pump producing such a negative pressure is not necessarily configured to produce a pressure above the critical pressure for the medium at the pore. Therefore, the invention as recited in claims 35 (and 41) of the instant application is believed to be novel and non-obvious over *Bjorkman*, *Moulton*, or *Kitajima et al.* Claims 35, (as well as claims 41, 47, and 48) are, therefore, believed to be patentable over these references.

Because claims 36-40 are ultimately dependent on claim 35 (and because claims 42-46 are ultimately dependent on claim 41), they are believed to be patentable for at least the same reasons.

New claims 49 and 50 are similarly believed to be patentable over *Bjorkman*, *Moulton*, and *Kitajima et al.*, taken alone or in combination, since none of the cited art includes determining a critical pressure, as is recited in new claim 49.

CONCLUSION

In view of the amendments and reasons provided above, it is believed that all pending claims are in condition for allowance. The amendments clarify the patentable invention without adding new subject matter. Applicant respectfully requests favorable reconsideration and early allowance of all pending claims.

If a telephone conference would be helpful in resolving any issues concerning this communication, please contact Applicant's attorney of record, Jeffrey R. Stone at (612) 436-3151.

Respectfully submitted,

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